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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,130	05/14/2001	Keith H.S. Campbell	1966.001001	8898

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EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 10/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/600,130	Applicant(s) CAMPBELL, KEITH H.S.	
	Examiner Joseph Voitach	Art Unit 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 42-82 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

This application is a national stage filing of PCT/GB00/00086, filed January 13, 2000 (amended July 12, 2000 and October 13, 2000), which claims benefit to provisional application 60/130,546 filed April 22, 1999 and claims benefit to foreign application 9900734.6 filed January 13, 1999 in Great Britain.

Applicants' preliminary amendment filed October 13, 2000, paper number 2, has been received and entered. The specification has been amended. Claims 2-42 have been canceled. Applicants' second preliminary amendment filed May 14, 2001, paper number 7, has been received and entered. Claim 1 has been canceled. claims 42-82 have been added. Claims 42-82 are pending and currently under examination.

Election/Restriction

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 42-68, 73, 77, 80, 81 and 82, drawn to a method of producing an animal embryo comprising passing a nuclear donor through a first recipient oocyte, then into a second oocyte or zygote, the embryo produced by this method, and a cell line produced from the embryo

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Group II, claim(s) 69-72, 74, 75, 76 78, 79, drawn to a method of preparing an animal comprising culturing an embryo into a fetus then into an animal, the animal produced by this method, and a cell line produced from the animal and/or fetus.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

A) The invention has no special technical feature that defined the contribution over the prior art, or

B) Unity of invention between different categories of inventions will only be found to exist if specific combinations of inventions are present. Those combinations include:

- 1) A product and a special process of manufacture of said product.
- 2) A product and a process of use of said product.
- 3) A product, a special process of manufacture of said product, and a process of use of said product.
- 4) A process and an apparatus specially designed to carry out said process.
- 5) A product, a special process of manufacture of said product, and an apparatus specially designed to carry out said process.

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The allowed combinations do not include multiple products, multiple methods of using said products, and methods of making multiple products as claimed in the instant application, see MPEP § 1850.

Applicant's claims encompass multiple inventions and do not have a special technical feature which link the inventions one to the other, and lack unity of invention.

The inventions are distinct, each from the other because:

The method of producing a reconstituted embryo by passing the nuclear donor through more than one recipient oocyte has been previously disclosed in the art. Wheeler (US Patent 5,942,435) describes the culturing of embryonic stem cells for the production of a transgenic swine (see abstract). In the detailed teaching for culturing and maintaining the embryonic stem cell, it is taught that the stem cell can be serially passaged by nuclear transfer into an oocyte using nuclear transfer technology (column 11; lines 30-40). Subsequently, the stem cell can be used to generate an embryo or a cloned animal. Because the method encompassed by claim 42 for providing an embryo has been previously disclosed in the art, there is not special technical feature which links the various methods instantly claimed.

The inventions above are independent and distinct, each from the other. They have acquired a separate status in the art and require independent searches. The search for each of the above invention is not co-extensive particularly with regard to the literature search. Further, a

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reference which would anticipate the invention of any one Group would not necessarily anticipate or make obvious any of the other groups.

For these reasons restriction for examination is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist Pauline Farrier whose telephone number is (703)305-3550.

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Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.



Joseph T. Woitach

DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1800/1630